This paper is filed in response to the Notice of Non-Compliant Amendment mailed on August 18, 2008. The status identifier for claim 13 has been corrected herein. No other changes to the claims are being made. For the convenience of the Examiner, the previously submitted Remarks are repeated below.

This application, as amended herein, contains claims 1-36.

Claims 25-36 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

Claims 25-36 have been clarified herein to recite a computer usable medium, which is a tangible object or article of manufacture. Such claims, which are directed to an article of manufacture and have program code embedded thereon for causing a computer (and in this case also related hardware) to function in a particular way have been recognized as being directed to patentable subject matter since approximately 1994. In fact MPEP 2106.01 states, in pertinent part:

> Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed.

1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. <u>When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized (emphasis added)</u>.

In the present case, it is clear that what is being claimed permits the function to be realized. It produces a useful, concrete and tangible result. Thus it is submitted that the rejection under 35 U.S.C. 101 should be withdrawn.

Claims 6, 8, 11, 18, 20, 30 and 32 were rejected under 35 U.S.C. 112, second paragraph. Claims 8, 20 and 32 have been amended herein to use alternative language, which was the original intent, as the use of "one of A and B" has generally been construed to mean "A or B". The antecedent basis issues have been addressed by amendment. In claim 11, the word "permitting" has been changed to "permit", and is a reason for why transfer is suspended.

Claims 1-2, 7-8, 13, 16, 19-20, 25-26 and 30-32 were rejected as being anticipated by Chang. Claims 5-6, 17-18 and 29 were rejected as obvious over Chang. Claims 3-4, 14-15, 27 and 28 were rejected as obvious over Chang in view of Christopher. Claims 9, 21 and 33 were rejected as obvious over Chang in view of Cho. Claims 10, 22 and 34 were rejected as obvious over Chang and Cho, in view of Fald. Claims 11, 23 and 35 were rejected as obvious over

Chang in view of Serichol Blasco and Watanabe et al. Finally claims 12, 24 and 36 were rejected as obvious over Chang in view of Fanning. These rejections are respectfully traversed.

Applicants' invention, as set forth in claim 1 (and in independent claims 13 and 25, which have been amended in the same manner) is directed to, in a system having a client computer, and apparatus for connecting said client computer to a network having a server for backing up said client computer, a method for transferring data from said client computer to said server, comprising connecting said client computer to said network; backing up data on said client computer to a storage device attached to said network when said client computer is connected to said network; and transferring the data from said storage device to said server <u>to back up and retain said data on said server</u>.

In the rejection, the Examiner relies, in the top two lines of page 4 of the office Action, on "transferring the data from said storage device to said server (Paragraph 0039; 0062. data is transferred to the computing device 170.)."

It is respectfully pointed out that paragraph [0018] of Chang states:

[0018] No data is retained by the computing device where the communication device is connected. In the aforementioned printing scenario, if the user is using another person's desktop for printing, the user must be sure that no document or data is accidentally left on the desktop. When using another person's PC there is always concern that a confidential document could be

13

left on the PC. <u>**In the present invention, one or more software components**</u> <u>**embedded in the device ensure that no data relating to the output of the**</u> <u>**digital document is retained by the computing device**</u> (emphasis added).

Chang clearly has no intention of backing up and retaining the data on computing device 170. In fact, Chang requires removing the data, in order to maintain security of the data. Thus, Chang does not anticipate Applicants' invention. Further, because Chang actually teaches discarding the data, it can and does not render Applicants' invention, as set forth in claim 1 (and independent claims 13 and 25), obvious, because Chang actually teaches away from Applicants' invention. Thus, it is submitted that independent claims 1, 13 and 25 are all directed to patentable subject matter.

The remaining claims depend from one of independent claims 1, 13 or 25. These claims contain further recitations, which in combination with those of the independent claim from which they depend, are not shown or suggested in the art of record.

With specific reference to claim 5 (and to claims 17 and 29) there is no teaching or suggestion in Chang of "creating a new data set on said storage device for transfer to said server each time said client computer is connected to said network <u>so as to create data sets.</u>" Further, as set forth in claim 6 (and in claims 18 and 30) there is no teaching or suggestion in Chang of the "data sets being transferred to said server in an order in which said data sets were created." Paragraphs [0058] to [0062] of Chang simply do not discuss multiple data sets and

14

therefore can and do not discuss an order for transfer of such data sets. Chang simply does not teach or even remotely suggest claims 5, 6, 17, 18, 29 and 30. It is thus submitted that these claims are directed to patentable subject matter.

Claims 10, 22 and 24 specifically address the situation wherein if power to said client computer is turned on during transfer of data stored on said storage device in said client computer to said storage device attached to said network, said transfer of data is suspended while said client computer boots up. This is not what Fald, or any combination of Fald, Cho and Chang, teach. Fald, in paragraph 0063 merely teaches suspending data transfer if there is a power failure or a disconnection. It does not teach or suggest suspending data transfer between the client computer and the storage device connected to the network, due to booting up the client computer. This feature of Applicants' invention may be used to assure proper backup of files on the client computer, and not the intermediate storage device. Thus, it is submitted that claims 10, 22 and 34 are directed to patentable subject matter.

Claims 12, 24 and 36 are directed to a situation wherein if said client computer is disconnected from said network during a first backing up of data on said client computer to a storage device attached to said network, and said client computer is again connected to said network, the method further comprises backing up said client computer to said storage device on said network a second

15

time, and transferring sequentially to said server data transferred to said storage device before said client was disconnected from said network, and then data transferred to said storage device during said second time. The combination of Chang and Fanning et al. do not teach or suggest backing up to an intermediate device connected to the network, and from the intermediate device to a server. As noted above with respect to the independent claims from which these claims depend, Chang actually teaches away from this approach by requiring that data be discarded for security reasons, rather than be backed up. Thus it is submitted that claims 12, 24 and 36 are directed to patentable subject matter.

In view of the allowable nature of the subject matter of all of the claims, if the Examiner cannot issue an immediate allowance, it is respectfully requested that the undersigned be contacted to resolve any remaining issues.

Respectfully submitted,

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16